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09/583,011	05/30/2000	Ryuji Hirata	00390/LH	1526

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Frishauf Holtz Goodman Langer & Chick PC
767 Third Avenue
New York, NY 10017-2023

EXAMINER

SOLOMON, GARY L

ART UNIT	PAPER NUMBER
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2615

8

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/583,011

Applicant(s)

HIRATA ET AL.

Examiner

Gary L Solomon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 & 18-20 is/are rejected.
- 7) ☒ Claim(s) 16-17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date .
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15, Line 26, "said power supply" recites multiple antecedent basis.

There are two power supplies: the first and second. Examiner suggests distinctly labeling which power supply the applicant is claiming.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-11 & 12-14, & 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Okada (US 5,664,243).

For claim 1, Okada discloses an electronic camera system comprising:

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a first recording medium receiving portion provided in an electronic camera to receive a first recording medium for recording image data (Column 9, Line 40 through Column 10, Line 35);

a second recording medium receiving portion for receiving a second recording medium having a recording capacity larger than that of the first recording medium (Column 9, Line 40 through Column 10, Line 35. The first recording medium is a silver halide film and the second medium is a video cassette. A Video cassette is a larger medium than a film medium. Video cassettes are also motion video whereas films are still pictures. A larger capacity is required to record video than a still shot.);

a first power supply provided in the electronic camera to supply power in writing the image data on at least the first recording medium (Figure 113, Element 17; Column 72, Lines 30-65);

a second power supply having a power supply capacity larger than that of said first power supply (Figure 113, Element 18, Column 72, Lines 49-58); and

an electronic camera expansion unit (Figure 113) for receiving said second power supply (Figure 113, Element 18), said electronic camera expansion unit (Figure 113) being detachable from the electronic camera (Figures 110-117),

wherein said second power supply supplies power to write data on the second recording medium when said electronic camera expansion unit is attached to the electronic camera (Column 72, Lines 49-58).

For claim 2, Okada discloses all the previous limitations further comprising:

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determination means for determining whether said electronic camera expansion unit is attached to the electronic camera (Column 71, Lines 64 through Column 72, Line 5), and

notification means for, when the second recording medium is inserted into said second recording medium receiving portion (Figure 115, Element 10; Operation Indication Portion), and said determination means determines that said electronic camera expansion unit is not attached to the electronic camera, notifying a user that said electronic camera expansion unit is not attached to the electronic camera (The operation indication portion is in essence exactly what it says. In Column 72, Lines 1-20, Okada says it displays information on the liquid crystal display. Therefore, it would indicate the information on whether it is attached it or not. If it wasn't attached, it couldn't function.).

For claim 3, Okada discloses all the previous limitations further comprising:

determination means for determining whether said electronic camera expansion unit is attached to the electronic camera, and means for, when said determination means determines that said electronic camera expansion unit is not attached to the electronic camera, inhibiting drive of the second recording medium and a write/read of image data (Column 71, Lines 64 through Column 72, Line 20, By grounding the terminals, the camera would not be permitted to transmit data to the recording unit. Therefore, the drive would be inhibited.).

For claim 4, Okada discloses all the previous limitations and also wherein:

wherein said electronic camera expansion unit comprises a grip portion (Figure 113, 1C) incorporating said second power supply (Figure 113, Element 18; Column 72, lines 49-56).

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For claim 5, Okada discloses all the previous wherein the electronic camera further comprises a first power supply-receiving portion for receiving said first power supply (Figure 2, Element 17), said electronic camera expansion unit further comprises:

- a unit main body (Figure 115 Element 1A),

- a second power supply receiving portion for receiving said second power supply (Figure 115, Element 18

- an attaching mechanism for detachably attaching said unit main body to the electronic camera (Figure 115 Element 3A), and

- data connection means, electrically connected to the electronic camera, for transmitting/receiving the image data (Figure 115, Element 8A), and

- said second recording medium receiving portion (Figure 112, Element 15; Video Tape Deck) is provided in said unit main body (Figure 115, Element 1A).

For claim 6, Okada discloses all the previous limitations and also wherein:

- said unit main body (Figure 113, Element 1C) comprises a grip portion incorporating said second power supply receiving portion (Figure 112, Element 15; Video Tape Deck) and arranged on an end portion side in a horizontal direction of the electronic camera (Figure 119), and a substantially plate-like flat portion (Figure 117, Element 24) integrated with an end portion of said grip portion and attached to a bottom surface of the electronic camera (Figure 117), and incorporating said second recording medium receiving portion (Figure 112, Element 15; Video Tape Deck) and having said data connection means (Figure 117, Element 8A; This is not labeled, but is disclosed in Column 73, Lines 30-46) formed at an abutment portion against the bottom surface of the electronic camera (Figure 117).

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The camera in the Okada reference has 6 bottom portions, since it is formed in a cube like rectangular pattern. Therefore, the connection of the unit main body in the expansion in Figure 117 is against a bottom surface.

For claim 7, Okada discloses all the previous limitations and also wherein:

said second recording medium has a rotating member (A video cassette has 2 reels that spin.), and

said second recording medium receiving portion (Figure 112, Element 15; Video Tape Deck). is arranged on a side of said grip portion (Figure 117, Element 1C) of said flat portion (Figure 117, Element 24).

For claim 8, Okada discloses all the previous limitations and also wherein:

said flat portion has, at a position separated from said grip portion via said second recording medium receiving portion (Figure 117)

a circuit section for executing the write/read of the image data on/from the second recording medium and transmission/reception of the image data through said connection means by power supplied from said second power supply (Column 71 Line 74, Column 72, Line 57).

For claim 9, Okada discloses all the previous limitations and also wherein:

the electronic camera has a cover for protecting an insertion part of the first recording medium into said first recording medium receiving portion (Column 10, Lines 5-18), and said grip portion has a recessed portion not to impede opening/closing said cover (Figure 5 and 6).

For claim 10, Okada discloses all the previous limitations and also wherein:

said grip portion has, at an upper portion, a release switch for instructing a release operation in the electronic camera (Figure 117, Element 7, Column 71, Lines 30-65).

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For claim 11, Okada discloses all the previous limitations and also wherein:

the second recording medium can be freely removed from said second recording medium receiving portion, and said second recording medium receiving portion is arranged at a portion where the second recording medium can be removed even while said unit main body is being attached to the electronic camera (Figure 5).

For claim 13, Okada discloses all the previous limitations and also wherein:

said flat portion has, at positions corresponding to the plurality of contacts forming said connection means (Figure 117, Element 8A)

a circuit section for executing the write/read of the image data on/from the second recording medium and transmission/reception of the image data through said connection means by power supplied from said second power supply (Column 9, Line 10 through Column 10, Line 8).

The flat portion in Figure 117 has contacts (Element 8A) on its end for data transfer.

For claim 14, Okada discloses all the previous limitations and also wherein:

said unit main body further comprises a switch for inhibiting the write/read of the image data on/from the second recording medium (Column 71 Line 6, Column 72, Line 57).

For claim 18, Okada discloses all the previous limitations and also wherein:

the electronic camera comprises detection means for detecting an attached state of said electronic camera expansion unit to the electronic camera (Figure 118; Column 73, Lines 35-47; Lines 59-64), and

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a first power supply receiving portion for receiving said first power supply, and said electronic camera expansion unit comprises the second recording medium receiving portion (Figure 113, Element 17),

a second power supply receiving portion for receiving said second power supply (Figure 113, Element 18),

an attaching mechanism for attaching a unit main body of said electronic camera expansion unit to the electronic camera (Figure 117, Element 3A), and connection means, electrically connected to the electronic camera (Figure 117, Element 8A), for transmitting/receiving the image data (Also See Figure 135; Column 76, Lines 17-27).

It is inherent in the device of Okada that the unit main body (attaching grip portion) must be detected by the electronic camera in order to transmit electrical data. If there were no detection, there would be no transmission of data.

For claim 19, Okada discloses all the previous limitations and also wherein:

said attaching mechanism has, on an abut surface against the electronic camera (Figure 117), a projecting portion (Figure 117, Element 26) for positioning the electronic camera (Figure 117), and

said detection means is arranged at a position corresponding to the projecting portion to detect that the projecting portion abuts (Column 117, Element 8A (not shown) and 9B).

5. Claims 1 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Saito (US 6,525,767).

For claim 1, Saito discloses an electronic camera system comprising:

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a first recording medium receiving portion provided in an electronic camera to receive a first recording medium for recording image data (Figure 2, Element 23);

a second recording medium receiving portion for receiving a second recording medium having a recording capacity larger than that of the first recording medium (Figure 2, Element 30);

a first power supply provided in the electronic camera to supply power in writing the image data on at least the first recording medium (Figure 2, Element 17 & Power Source in Memory Card);

a second power supply having a power supply capacity larger than that of said first power supply (Figure 2, Element 34); and

an electronic camera expansion unit for receiving said second power supply, said electronic camera expansion unit being detachable from the electronic camera (Figure 2, Element 20),

wherein said second power supply supplies power to write data on the second recording medium when said electronic camera expansion unit is attached to the electronic camera (Column 8, Line 58 through Column 9, Line 35).

For claim 20, Okada discloses all the previous limitations and also wherein:

the first recording medium comprises a memory card, and the second recording medium comprises a hard disk (Figure 1) The laptop computer contains a hard drive and the memory card is explicit in Element 20.

Claim Rejections - 35 USC § 103

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (US 5,664,243).

The engaging member with a tripod screw hole is data connection means in the applicant's specification. The applied prior art does not teach the tripod screw hole as a data connecting mechanism.

However, Okada provides data connection and attaching mechanism for attaching the secondary recording means and the camera together. The connection means is of a non-critical type. Again, the prior art teaches connectors to enable transfer of data. Therefore, it would have been obvious to change form of shape of a connector as a matter of design.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (US 5,664,243).

For claim 15, Okada discloses all the previous limitations, but lacks teaching wherein said unit main body further comprises in input terminal for supplying external DC power to said power supply.

The claim has previously been rejected under USC 112, 2nd Paragraph. Thus, the examiner will interpret the power supply as the second power supply.

Nevertheless, the use of supplying external DC power to a power supply is well known in the art and therefore would have been obvious to one of ordinary skill in the art at the time of the

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invention in order to use the unit main body extension for periods of time of time longer than the power supply's battery life. Official Notice is hereby given.

Allowable Subject Matter

9. Claims 16 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. For claim 16, Okada discloses all the previous limitations, but the grip portion (Figure 5, Element CG) doesn't sandwich the electronic camera. It only connects to a surface. Therefore the Okada reference does not read on claim 16.

11. Claim 17 is dependent on claim 16.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary L Solomon whose telephone number is (703)-305-4370.

13. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Vu Le can be reached on (703)-308-6613.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9314, (for informal or draft communications, please label
"Proposed" or "Draft")

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the customer service number (703) 306-0377.



March 22, 2004



VU LE
PRIMARY EXAMINER